

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT
ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)**Docket Number (Optional)
LET01-GN005First named inventor: McKibbenApplication No.: 10/731,906Art Unit: 2163Filed: 12/10/2003Examiner: LIE, ANGELA M.Title: CONTEXT INSTANTIATED APPLICATION PROTOCOL

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX (571) 273-8300

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Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee - required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional

1. Petition Fee☒ Small entity-fee \$ 810.00 (37 CFR 1.17(m)). Application claims small entity status. See 37 CFR 1.27.☐ Other than small entity-fee \$ _____ (37 CFR 1.17(m))**2. Reply and/or fee**

A. The reply and/or fee to the above-noted Office action in
the form of R.C.E. AND AMENDMENT (identify type of reply):

☒ has been filed previously on 8/17/201012/21/2010 HBLANCO 00000061 10731906☒ is enclosed herewith.01 FC:2453810.00 OP

B. The issue fee and publication fee (if applicable) of \$ _____.

☐ has been paid previously on _____.☐ is enclosed herewith.

(Page 1 of 2)

This collection of information is required by 37 CFR 1.137(b). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ _____ for a small entity or \$ _____ for other than a small entity) disclaiming the required period of time is enclosed herewith (see PTO/SB/63).

4. STATEMENT: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c), subsections (III)(C) and (D)).]

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

Scott R. Stanley Signature
 Scott R. Stanley
 Type or Printed name
 425 Walnut St., Suite 1800
 Address
 Cincinnati, OH 45202
 Address

December 15, 2010 Date
64,802
 Registration Number, If applicable
513-357-9616
 Telephone Number

Enclosures:

- ☒ Fee Payment
- ☒ Reply
- ☐ Terminal Disclaimer Form
- ☒ Additional sheets containing statements establishing unintentional delay
- ☒ Other: LETTER RE: PETITION FOR REVIVAL

CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)]

I hereby certify that this correspondence is being:

- ☒ Deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Mail Stop Petition, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.
- ☐ Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571) 273-8300.

December 15, 2010
 Date

Pam Rein
 Signature

Pam Rein
 Typed or printed name of person signing certificate



Certificate of Mailing

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12/15/2010
Date

Pam Rein
Name

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of :

Applicant : McKibben, et. al.
Serial No. : 10/731,906
Filed On : 12/10/2003
Title : CONTEXT INSTANTIATED APPLICATION PROTOCOL
Docket No. : LET01-GN005
Examiner : Lie, Angela M.
Art Unit : 2163

Attention: Office of Petitions
Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PETITION TO REVIVE ABANDONED APPLICATION UNDER 37 C.F.R. 1.137
(UNINTENTIONAL)

The present submission requests revival of the unintentionally abandoned above-referenced application. The Notice of Abandonment (mailed on September 13, 2010) states that the application is abandoned in view of "Applicant's failure to timely file a proper reply to the Office letter mailed on 17 February 2010." Further, the Notice of Abandonment states that "[n]o reply has been received." Applicant respectfully submits that the requirements of 37 C.F.R. § 1.137(b) are satisfied and request revival of the application.

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Applicant respectfully submits that Applicant's reply to the February 17, 2010, Office action was timely and proper.

Applicant's Reply was Timely

Applicant respectfully submits that Applicant did, in fact, timely file a reply to the February 17, 2010, Office action. To be deemed timely, a reply (with a request for an extension of time) to the February 17, 2010, Office action must have been filed by August 17, 2010. Applicant filed a Request for Continued Examination and Amendment ("RCE/Amendment"), a copy of which is submitted herewith, on August 17, 2010. The Advisory Action (mailed on August 30, 2010) alleges that the RCE/Amendment was filed on August 19, 2010. This is inaccurate. While the Office may have received the RCE/Amendment on August 19, 2010, Applicant mailed (with a signed Certificate of Mailing) the RCE/Amendment to the Office via first class U.S. mail on August 17, 2010.

Under 37 C.F.R. 1.8(a)(1), correspondence to the Office will be considered as being timely filed if:

- (i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:
 - (A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail;
 - (B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6 (d); or
 - (C) Transmitted via the Office electronic filing system in accordance with § 1.6(a)(4); and
- (ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

Applicant's RCE/Amendment satisfies the requirements of 37 C.F.R. 1.8(a)(1). First, the RCE/Amendment was mailed via first class U.S. Postal Service mail with sufficient postage on August 17, 2010, which is prior to the expiration of the set period of reply.

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Second, both the RCE/Amendment and Transmittal Form submitted therewith included separate Certificates of Mailing signed by paralegal Pamela Rein (a paralegal working with Applicant's attorney) certifying that those documents were being mailed via first class U.S. Postal Service mail with sufficient postage on August 17, 2010. Pamela Rein had a reasonable basis to expect that the RCE/Amendment would be mailed on August 17, 2010. Therefore, the mailing of the RCE/Amendment satisfies the requirements of 37 C.F.R. 1.8(a)(1), and was timely filed on August 17, 2010.

Applicant's Reply was Proper

Applicant respectfully submits that Applicant's RCE/Amendment was a proper reply. The Advisory Action alleges,

"Applicant's arguments fail to comply with 37 C.F.R. 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In other words, stating that prior art does not teach any of the claimed limitations does not pose an argument explaining why the prior art fails to teach the claimed invention."

Such allegation is incorrect. First, the RCE/Amendment clearly stated on a claim-by-claim basis which specific claim elements and/or limitations the Office action failed to identify as being taught by the cited reference (Petersen). Second, the RCE/Amendment clearly stated on a claim-by-claim basis which specific claim elements and/or limitations Petersen failed to teach.

Under 37 C.F.R. 1.114(a), an applicant may request continued examination of the application by filing a submission and the fee set forth in 37 C.F.R. 1.17(e). Under 37 C.F.R. 1.114(c), a submission may include, but is not limited to, an amendment to the claims and/or new arguments. 37 C.F.R. 1.114(c) further states that, if a reply to an Office action under 35 U.S.C. 132 is outstanding, the submission must meet the reply requirements of 37 C.F.R. 1.111. 37 C.F.R. 1.111 states, in part,

"The reply by the applicant or patent owner must be reduced to a writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action. The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.

...

The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section."

The RCE/Amendment satisfied the requirements for a proper request for continued examination and submissions. The RCE/Amendment included a request for continued examination and the submission required under 37 C.F.R. 1.114(a). Further, the RCE/Amendment included amendments to the claims (e.g., new claims 49 and 50) and new arguments (e.g., the Office action failed to identify where in Petersen each and every claim element/limitation was taught, and that Petersen, in fact, failed to teach each and every claim element/limitation). Both amendments and new arguments are identified as acceptable submissions under 37 C.F.R. 1.114(c).

Further, the RCE/Amendment satisfied the requirements of 37 C.F.R. 1.111 because it was a writing which distinctly and specifically points out the supposed errors in the examiner's action and replied to every ground of objection and rejection in the prior Office action. The RCE/Amendment stated on a claim-by-claim basis the deficiencies with the Office action and addressed each and every rejection identified in the Office action. Specifically, for each pending claim, the RCE/Amendment identified the specific claim elements and/or limitations that the Office action failed to identify as being taught by the Petersen. For example, regarding independent claim 1, on pages 15-16 of the RCE/Amendment, Applicant identifies specific claim elements that the Office action fails to allege are taught by Petersen, and Applicant identifies specific

claim elements that Petersen fails to teach¹. Similarly, Applicant identified specific claim elements and/or limitations for all other claims.

The Office action simply failed to present a prima facie case of anticipation, and the RCE/Amendment pointed out with specificity which claim elements and/or limitations were not anticipated by Petersen. MPEP 2131 states, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Office action failed to prove that each and every claimed element was expressly found or inherently described by Petersen.

Additionally, the Federal Circuit has stated: “the examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a prima facie case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Accordingly, “the Patent Office has the initial duty of supplying the factual basis for its rejection. It may not . . . resort to speculation, unfounded assumptions or hindsight

¹ RCE/Amendment (pages 15-16): “Regarding independent claim 1, the Office action fails to identify what portion of Petersen allegedly teaches that the contextual metadata is associated with the user, the element of automatically tagging contextual information related to the user, the software tool, and the first context to the data as contextual metadata upon one or more data operations being performed on the data while in the first context to which the software tool is associated, and the element of automatically tagging contextual information related to the user, the software tool, and the second context to the data as contextual metadata upon one or more data operations being performed on the data while in the second context to which the software tool is associated. For at least these reasons, the Office action fails to present a prima facie case of anticipation.

Further, Petersen fails to teach each and every element of claim 1 as claimed. Among other elements, Petersen fails to teach that the contextual metadata is associated with the user, the element of automatically tagging contextual information related to the user, the software tool, and the first context to the data as contextual metadata upon one or more data operations being performed on the data while in the first context to which the software tool is associated, and the element of automatically tagging contextual information related to the user, the software tool, and the second context to the data as contextual metadata upon one or more data operations being performed on the data while in the second context to which the software tool is associated. For at least these reasons, Petersen fails to teach each and every element of the claimed invention.”

For at least these reasons, claim 1 is not anticipated by Petersen.

reconstruction to supply deficiencies in its factual basis.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). As discussed at length in the RCE/Amendment, the Office action failed to bear the initial burden of presenting a prima facie case of unpatentability. Specifically, the Office action failed to bear to burden of proving a prima facie case of anticipation.

An Examiner is required under 37 CFR 1.104(c)(2) to: 1) point out with particularity where each and every element of a claim may be found in a cited reference; and 2) explain the pertinence of each cited reference as indicated hereafter:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified. (37 CFR 1.104(c)(2))

In view of the foregoing, if an Office Action fails to provide the requisite factual basis for an anticipation rejection, it is submitted that the rejection is deficient as the Applicant is left to speculate as to the basis for the rejection. Citing *In re Oetiker*, the BPAI considers such a deficiency reversible error. *Ex parte Dykes et al.* Appeal No. 2009-7556 (BPAI). In the instant case, the Office action's anticipation analysis lacked specificity that left the Applicant to speculate as to the basis for the rejection.

Furthermore, the Federal Circuit has indicated that sufficiently particular factual findings (“without resort to speculation”) required for an anticipation rejection allow “an appellate court to fulfill its role of judicial review”:

“[I]n sum, we hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review. In particular, we expect that the Board's anticipation analysis be conducted on a limitation by limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings.” *Gechter v. Davidson*, 1167 F.3d 1454 (Fed. Cir. 1997)

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As discussed at length in the RCE/Amendment, the Office action's anticipation analysis was not conducted on a limitation by limitation basis, with specific fact findings for each contested limitation and satisfactory explanations for such findings.

Next, the RCE/Amendment satisfied the requirements of 37 C.F.R. 1.111 because it pointed out the specific distinctions believed to render the claims patentable over the applied reference. The RCE/Amendment stated on a claim-by-claim basis the specific distinctions believed to render the claims patentable over Petersen. Specifically, for each claim, the RCE/Amendment pointed out the specific claim language that Petersen fails to teach. Petersen's failure to teach one or more claim elements and/or limitations distinguish the claimed invention from Petersen.

Finally, the RCE/Amendment satisfied the requirements of 37 C.F.R. 1.111 because it was a bona fide attempt to advance the application. Further, the RCE/Amendment was more than a general allegation that the claims define a patentable invention, as it specifically pointed out how the language of the claims is patentably distinguished from the Petersen.

For at least the foregoing reasons, the RCE/Amendment satisfied the requirements of 37 C.F.R. 1.111 and 37 C.F.R. 1.114. Therefore, the RCE/Amendment was a proper reply.

Conclusion

Submitted herewith is a Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b) form (PTO/SB/64) and a Fee Transmittal form (PTO/SB/17). The Petition includes a statement that the entire delay from the due date of the required reply to the filing of the petition under 37 C.F.R. § 1.137(b) was unintentional. The Fee Transmittal form indicates that a check for the petition fee under 37 C.F.R. § 1.17(m) for a small entity (\$810.00) is submitted herewith.

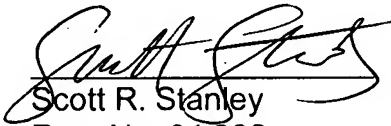
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Accordingly, Applicant respectfully submits that the requirements of 37 C.F.R. § 1.137(b) are satisfied and request revival of the application.

The Commissioner for Patents is hereby authorized to charge any fees that may be required by this paper, or to credit any overpayment, to Deposit Account 50-3072.

In the event that the Office wishes to discuss any aspect of this paper, please contact the undersigned at the telephone number indicated below.

Respectfully submitted,


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30074
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